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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,244	04/06/2004	Rainer Herrmann	GMH/416/US	7479

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ALIX YALE & RISTAS LLP
750 MAIN STREET
SUITE 1400
HARTFORD, CT 06103

EXAMINER	
NGHIEM, MICHAEL P	

ART UNIT	PAPER NUMBER
2863	

DATE MAILED: 08/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/820,244	HERRMANN ET AL.	
	Examiner	Art Unit	
	Michael P. Nghiem	2863	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 May 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12,14-16 and 18-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12,14-16 and 18-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

The Amendment filed on May 22, 2006 has been acknowledged.

Claim Objections

Claims 1, 8, 18, and 19 are objected to because of the following informalities:

- claim 1, the leading step (lines 2-3) is not related to the other steps.

- claims 8, 18, 19, the microwave generator (line 3) and the measuring and evaluation electronics for determining the mass (lines 4-6) are not related to other elements.

- claims 8, 18, 19, should insert – the – before "active substances" (line 7).

Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-12, 14-16, and 18-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims do not produce any tangible results. The practical application of the claimed invention cannot be realized until the information determined is conveyed to the user. For the result to be tangible, the determined mass would need to outputted to a user or displayed to a user or stored for later use by a user. Hence, the claims are treated as non-statutory functional descriptive material (see MPEP 2106 and http://www.uspto.gov/web/offices/com/sol/og/2005/week47/patgupa.htm).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Herrmann et al. (US 6,837,122).

Regarding claim 8, Herrmann et al. discloses an apparatus (Figs. 1-2) for determining the mass of portioned units of active substances (3, 6, 8) (Abstract, lines 1-2), in particular capsules, tablets or dragees (Fig. 3), which comprises a microwave generator

(18), a microwave resonator (15), a device for guiding the units of active substances through the microwave resonator (Fig. 2), measuring and evaluation electronics (Abstract, line 4) for determining the mass from the displacement A of the resonant frequency and the broadening B of the resonance curve (column 2, lines 24-29), and a device for removing individual units of active substances (8 is removed from 15 and into 14, Fig. 2), and a second microwave resonator (second 15) with measuring and evaluation electronics (each resonators has associated measurement electronics, Abstract, line 4) for determining the mass of the units of active substances (Abstract, lines 5-8) before filling (before filling in 14, Fig. 2).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Herrmann et al. in view of Mayer et al. (US 5,602,485).

Hermann et al. further discloses that the devices for guiding the units of active substances have a tube (22 in 15, Fig. 3) through which the units of active substances (8) are conveyed (Fig. 3).

However, Herrmann et al. does not disclose that the units of active substances are conveyed by an air stream.

Nevertheless, Mayer et al. discloses that the units of active substances (14's) are conveyed by an air stream (Fig. 1) for the purpose of processing the capsules at a high rate of speed (column 1, lines 32-35).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide Herrmann et al. with a conveying air stream as disclosed by Mayer et al. for the purpose of processing the capsules at a high rate of speed.

Response to Arguments

Applicant's arguments filed on May 22, 2006 have been considered but they are not persuasive.

With respect to the 35 USC 102 rejections, Applicants argue that Herrmann does not disclose "an apparatus for determining the mass of portioned units of active substances, in particular, capsules, tablets or dragees".

Examiner's position is that Herrmann discloses "an apparatus (Figs. 1-2) for determining the mass of portioned units of active substances (3, 6, 8) (Abstract, lines 1-2), in particular, capsules, tablets or dragees (8, Fig. 3)".
It is further noted by the Examiner that the limitation of "an apparatus for determining the mass of portioned units of active substances, in particular, capsules, tablets or dragees" is recited in the preamble. Thus, it has not been given patentable weight. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Applicants further argue that Herrmann does not teach "a device for removing individual units of active substances".

Examiner's position is that Herrmann discloses "a device for removing individual units of active substances" (since 8 is removed from 15 and into 14, Fig. 2).

Applicants further argue that Herrmann does not teach "determining the mass of portioned units of active substances" or "determining the mass of the units of active substances before filling".

Examiner's position is that Herrmann discloses "determining the mass of portioned units of active substances" (Abstract, lines 5-8) or "determining the mass of the units of active substances before filling" (before filling in 14, Fig. 2).

With respect to the 35 USC 103 rejection, Applicants argue that one of ordinary skill in the art in possession of Herrmann would have no incentive or motivation to seek out the teachings of Mayer.

Examiner's position is that the motivation to incorporate an air stream disclosed by Mayer to convey substances of Herrmann is for the purpose of improving the processing rate of the substance. This motivation is disclosed in Mayer (column 1, lines 32-35).

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael P Nghiem whose telephone number is (571)

272-2277. The examiner can normally be reached on M-H.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Barlow can be reached on (571) 272-2269. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MICHAEL NGHIEM
PRIMARY EXAMINER

Michael Nghiem

July 31, 2006